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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
10/589,890	08/18/2006	Masanori Nakamura	040302-0582	2473		
22428	7590	11/19/2008	EXAMINER			
FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				NGUYEN, CAM N		
ART UNIT		PAPER NUMBER				
1793						
MAIL DATE		DELIVERY MODE				
11/19/2008		PAPER				

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/589,890	NAKAMURA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Cam N. Nguyen	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08/12/08 (an election).
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
  - 4a) Of the above claim(s) 6-13 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 and 14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on originally filed is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/18/06</u> .  | 6) <input type="checkbox"/> Other: _____ .                        |

**DETAILED ACTION**

**Response to Election/Restrictions**

1. Applicant's election without traverse of Group I, claims 1-5 & 14, in the reply filed on 08/12/08 is acknowledged.
2. Claims 6-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention(s), there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 08/12/08.

**Claim Rejections - 35 USC § 112 (Second Paragraph)**

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 & 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- A. Regarding claim 4, line 2-3, the proper Markush terminology is --wherein the noble metal is at least one selected from the group consisting of platinum, palladium and rhodium.--
- B. Regarding claim 4, line 4-5, the proper Markush terminology is -- the transition metal is at least one selected from the group consisting of manganese, iron, cobalt, nickel, copper and zinc.--

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C. Regarding claim 4, last two lines, the proper Markush terminology is -- the carrier is at a porous substance of at least one selected from the group consisting of alumina, ceria, zirconia, silica, titania and ~~silica alumina~~ silica-alumina.--

D. Regarding claim 5, the proper Markush terminology is --a compound composed of at least one selected from the group consisting of cerium, neodymium, praseodymium, lanthanum, zirconium, barium and magnesium.--

### **Double Patenting**

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

A. Claims 1-5 & 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, & 6 of copending Application No. 11/079,270. Although the conflicting claims are not identical, they are not patentably distinct from each other because: *the catalyst structure of the claimed catalyst and the*

*disclosed (copending '270) catalyst are the same because they both contain the same support, noble metal particle, and transition metal particle.*

B. Claims 1-5 & 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 & 3-6 of *copending Application No. 11/079,377*. Although the conflicting claims are not identical, they are not patentably distinct from each other because: *Same reasons as provided in A above.*

C. Claims 1-5 & 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, & 7 of *copending Application No. 11/722,275*. Although the conflicting claims are not identical, they are not patentably distinct from each other because: *Same reasons as provided in A above.*

D. Claims 1-5 & 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 & 4-6 of *copending Application No. 11/578,295*. Although the conflicting claims are not identical, they are not patentably distinct from each other because: *Same reasons as provided in A above.*

E. Claims 1-5 & 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of *copending Application No. 10/586,533*. Although the conflicting claims are not identical, they are not patentably distinct from each other because: *Same reasons as provided in A above.*

F. Claims 1-5 & 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 & 4-6 of *copending Application No. 10/584,346*. Although the conflicting claims are not identical, they are not patentably distinct from each other because: *Same reasons as provided in A above.*

G. Claims 1-5 & 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2-3, & 7 of copending Application No. 10/584,243. Although the conflicting claims are not identical, they are not patentably distinct from each other because: *Same reasons as provided in A above.*

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Citations**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All references are cited for related art. See PTO-892 Form prepared.

**Conclusion**

6. Claims 1-14 are pending. Claims 1-5 & 14 are rejected. Claims 6-13 are withdrawn due to nonelected (distinct) invention(s). No claims are allowed.

**Contacts**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner CAM N. NGUYEN, whose telephone number is 571-272-1357. The examiner can normally be reached on M-F, 9:00 AM - 6:30 PM, at alternative work site.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cam N. Nguyen/

Primary Examiner

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/C. N. N./

November 17, 2008